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09/863,683	05/22/2001	Perry Biancavilla	10005929-1	1273

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER
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CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/863,683

**Applicant(s)**

BIANCAVILLA, PERRY

**Examiner**

Siegfried E. Chencinski

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4, 7-10 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-10 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**1. Claims 1-21 are rejected** under 35 U.S.C. 103(a) as being disclosed by Kalin (Walmart Struggles to Get Up to Speed

[http://webbusiness.cio.com/archive/12400\\_walmart\\_content.html](http://webbusiness.cio.com/archive/12400_walmart_content.html)).

**Re. Claim 1**, Kalin discloses or suggests a method for distributing purchased goods at retail or wholesale outlet stores, comprising the steps of:

- providing a mechanism for customers to remotely order the goods stored at the one or more retail and/or wholesale outlet stores and receive order confirmation information (page 1, ll. 1-9, 24-36);
- wherein the one or more agreements provide that, upon presentation of the order confirmation information at a retail and/or wholesale outlet store associated with the order confirmation information, possession of goods associated with the order confirmation information is transferred to a presenter of the order confirmation information (p. 2, ll. 11-13, in-store pick-up recommendation).
- electronically providing a retail or wholesale outlet store associated with the order confirmation information with a packing list associated with the order confirmation information after the order confirmation information is presented to the retail or wholesale outlet stores (p. 1, ll. 24-36; p. 2, ll. 11-13. This facility is made obvious because electronic order confirmation and a packing list or receipt of some kind, perhaps printed online by or for the customer, are suggested by Kalin by the disclosure of the ability to return items, which has been a very broad practice and

by the recommendation in the Kalid disclosure for an in-store pick-up option of an online purchase.).

Kalin does not explicitly disclose entering into one or more agreements with one or more retail and/or wholesale outlet stores to store and distribute goods that are different from displayed goods at the retail and/or wholesale outlet stores. However, Kalin discloses that 600,000 products were for sale on the Walmart web site in January 2000 versus the 100,000 products found in a typical Walmart Supercenter. This arrangement suggests the claimed concept of one or more retail and/or wholesale outlet stores to store and distribute goods that are different from displayed goods at the retail and/or wholesale outlet stores. Further, it is well known that the products carried by retail stores and wholesale outlet stores are largely based on agreements with manufacturers or master distributors. Also, it has been well known that many if not most stores have traditionally taken orders for products they do not stock. With online shopping and order placement and instant electronic network communications between retailers and distributors and manufacturers, such orders are quickly communicated to a manufacturer or to a distribution center belonging to the retailer or to a manufacturer so that the product is quickly delivered to the store or to the customer and, in case of in-store pickup, the customer is told when they can pick up the product or have it delivered, as chosen by the customer.

Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the one or more agreements additionally require the retail or wholesale outlet stores to package goods associated with the order confirmation information after the order confirmation information is presented to the retail or wholesale outlet stores. However, instore packaging of products has been well known in retailing for generations. For example, premium coffee beans have been stored in bulk and packaged at the time of customer delivery, with or without on the spot grinding. Fruit and produce have likewise stored and dispensed in the same way. Small food stores have been accepting telephone orders for customer pick-up or for delivery to the customer since the telephone came into wide spread use. Large food stores began to offer remote online and telephone orders for groceries in the 1980's,

pioneered by companies such as Peapod, where a central computer server takes the order and electronically transmits the order to the pick-up or delivery location which has the items which have been ordered. When necessary, items not in stock at the primary delivery location are transshipped from the nearest in-stock location to the pick-up or delivery location. Large brick and mortar supermarkets such as Safeway joined in the 1990's. Such service has also been widely provided for decades by department stores such as Sears, Merwyn's, Hecht's, Macy's, etc. All of the items are packaged in carry out containers or bags for carry-out or delivery. In hardware products, many products still are distributed in bulk and stored in bins, barrels, sacks, etc. Examples are the large variety of fasteners known as nails and screws, and also hinges, batteries, small light bulbs, etc. These products are typically packaged in various ways at the time of purchase and pick-up by the customer. It would have been obvious to an ordinary practitioner at the time of Applicant's invention to have modified Kalin's disclosure with well known retailing practices to offer a method for distributing purchased goods at retail or wholesale outlet stores, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

**Re. Claim 2,** Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein at least one of the agreements provides one or more of the retail and/or wholesale outlet stores an exclusive territory with respect to distribution of the goods. However, it is well known that many manufacturers give exclusive geographic territories to retail or outlet stores as a mutually beneficial incentive for the retailer to promote the manufacturer's particular product line and to carry inventory of a mutually agreed items of the product line. This is a judgment made by each manufacturer as part of their distribution strategy for maximizing sales on each product category they are manufacturing. Therefore, it would have been obvious to the ordinary practitioner to combine the Kalin disclosure with well known distribution practices in order to provide a method for distributing purchased goods at retail or wholesale outlet stores wherein at least one of the agreements provides one or more of the retail and/or wholesale outlet stores an exclusive territory

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with respect to distribution of the goods, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

**Re. Claim 3**, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the step of entering into one or more agreements is preceded by the step of soliciting competing bids from prospective retail or wholesale outlet stores to provide storage and distribution services. However, it is a well known practice to solicit competing bids from prospective retail or wholesale outlet stores to provide storage and distribution services because a manufacturer normally contacts numerous retailers and/or outlet store operators in the geographic areas of interest to him to solicit bids or terms and conditions from such store operators before deciding on which store operators to enter into agreements with. Therefore, it would have been obvious to the ordinary practitioner to combine the Kalin disclosure with well known practices wherein the step of entering into one or more agreements is preceded by the step of soliciting competing bids from prospective retail or wholesale outlet stores to provide storage and distribution services, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

**Re. Claim 4**, Kalin discloses a method for distributing purchased goods at retail or wholesale outlet stores wherein the mechanism for customers to remotely order the goods comprises a Website (page 1, ll. 1-9, 24-36).

**Re. Claim 7**, Kalin suggests a method for distributing purchased goods at retail or wholesale outlet stores comprising the step of electronically transferring funds to a retail or wholesale outlet store associated with the order confirmation information after the order would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention because of the well known and virtually universal practice of retailers and distribution organizations transferring financial credit for sales to the location or outlet which actually transacts delivery of the merchandise. Financial responsibility accounting also suggests or requires such transfers because the cost of the goods shipped to and stored by the retail location must be accepted by the retail location except for cases of consignment, which is an exception and not a widespread practice. Whether this credit is given entirely to the delivery location or given in dual

fashion to the online facility and the pick-up location is immaterial because the ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious to transfer revenue funds to the store which accepts delivery of the product and which then will deliver the product to the customer.

**Re. Claim 8**, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the one or more agreements additionally require the retail or wholesale outlet stores to receive the goods in bulk containers. However, it is well known that many products are received in bulk containers by stores. This is directly related to claim 6, because products which are packaged in a store at the time of final transfer to the customer are by definition received in bulk packaging. Bulk packaging for delivery to retailers is as well known as the related instore packaging of products. It would have been obvious to the ordinary practitioner at the time of Applicant's invention to combine Kalin's disclosures with the requirement for the retail or wholesale outlet stores to receive the goods in bulk containers for final packaging for instore delivery to the customer, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

**Re. Claim 9**, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the one or more agreements additionally require the retail or wholesale outlet stores to return the bulk containers once the bulk containers are empty. However, it is well known that many industries find it economical to require retailers to return bulk packaging to the manufacturer. Examples include pallets, trailers, railcars, tank cars and trailers used for transporting liquid products. This is primarily a matter of the economics involved in each case. When the total costs of returning bulk containers exceed the cost of using new bulk packaging for each bulk shipment, then returns of bulk containers are not requested or even welcomed by the shipper of bulk products. It would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention combine Kalin's disclosures with the requirement for the retail or wholesale outlet stores to return the bulk containers once the bulk containers are empty return the bulk containers once the bulk containers

are empty, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

**Re. Claim 10**, Kalin does not explicitly disclose a method for distributing purchased goods at retail or wholesale outlet stores wherein the one or more agreements additionally require the retail or wholesale outlet stores to distribute the goods in intimate level protection packaging. However, it is a widespread, and virtually universal practice in the United States to provide the "intimate" type of packaging as defined in Applicant's specification, which describes intimate packaging to be the routine packaging commonly provided by retailers, such as paper and plastic bags, with or without handles, as is the norm in American retailing. It would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to combine Kalin's disclosures with one or more agreements which require the retail or wholesale outlet stores to distribute the goods in intimate level protection packaging, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

**Re. Claim 16**, Kalin discloses a processing system for distributing purchased goods at retail or wholesale outlet stores, comprising computer systems hardware, software and electronic communications networks to manage its national and global business, including online ordering of goods and services (The entire Kalin article is devoted to disclosing information about Walmart.com and specifically Walmart's national online shopping facilities as they looked in January 2000. Specific information of interest is on p. 1, ll. 24-26, p. 2, ll. 11-13, 19-29; and p. 2, l. 43 – p. 3, l. 21).

- Including are a large array of processors making the Walmart.com system work (p. 2, l. 43 – p. 3, l. 21).

Kalin does not explicitly disclose a processor configured to receive an inventory verification request and information pertaining to a geographic location, to identify one or more retail or wholesale outlet stores that are within a particular distance of the geographic location and that have in stock goods identified in the inventory verification request, and to generate a list of the one or more retail or wholesale outlet stores.



However, it was well known at the time of Applicant's invention that many processors were in use in US retailing, programmed to receive an inventory verification request and information pertaining to a geographic location, to identify one or more retail or wholesale outlet stores that are within a particular distance of the geographic location and that have in stock goods identified in the inventory verification request, and to generate a list of the one or more retail or wholesale outlet stores. Therefore, it would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to use Kalin's disclosure and well known information to distribute purchased goods at retail or wholesale outlet stores by making use of processors configured to receive an inventory verification request and information pertaining to a geographic location, to identify one or more retail or wholesale outlet stores that are within a particular distance of the geographic location and that have in stock goods identified in the inventory verification request, and to generate a list of the one or more retail or wholesale outlet stores, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

**Re. Claims 17-21**, Kalin does not explicitly disclose a system for distributing purchased goods at retail or wholesale outlet stores wherein:

**Re. Claim 17**, wherein the processor is further configured to generate order confirmation information associated with the goods identified in the inventory verification request and with one of the retail or wholesale outlet stores on the list.

**Re. Claim 18**, wherein the order confirmation information is associated with the retail or wholesale outlet store on the list that is closest to the geographic location.

**Re. Claim 19**, wherein the order confirmation information is associated with the retail or wholesale outlet store on the list that is selected by a purchaser of the goods.

**Re. Claim 20**, wherein the processor is further configured to provide a packing list associated with the goods identified in the inventory verification request in response to an indication that the order confirmation information has been

provided to the retail or wholesale outlet store associated with the order confirmation information.

**Re. Claim 21**, wherein the processor is further configured to initiate a transfer of funds in response to an indication that the order confirmation information has been provided to the retail or wholesale outlet store associated with the order confirmation information.

However,

**Re. Claim 17**, Kalin discloses the suggestion that Walmart use its brick-and-mortar system to its competitive advantage by giving the online customer the choice of picking up a Walmart online purchase at the store location of the customer's choice (p. 2, ll. 11-13). It would have been obvious to the ordinary practitioner at the time of applicant's invention to have one or more processors configured to generate order confirmation information associated with the goods identified in the inventory verification request and with one of the retail or wholesale outlet stores on the list because the customer would choose a store for personal pick-up of their purchased goods when the customer's circumstances make such pick-up their most convenient option.

**Re. Claim 18**, associating the order confirmation information with the retail or wholesale outlet store on the list that is closest to the geographic location would have been obvious to the ordinary practitioner with a geographically diverse system of retail stores because the customer would choose a store for personal pick-up of their purchased goods when the customer's circumstances make such pick-up their most convenient option.

**Re. Claim 19**, associating the order confirmation information with the retail or wholesale outlet store on the list that is selected by a purchaser of the goods location would have been obvious to the ordinary practitioner in the case of a geographically diverse system of retail stores because the customer would choose a store for personal pick-up of their purchased goods when the customer's circumstances make such pick-up their most convenient option.

**Re. Claim 20**, configuring the processor to provide a packing list associated with the goods identified in the inventory verification request in response to an indication that the order confirmation information has been provided to the retail or wholesale outlet store associated with the order confirmation information would have been obvious to the ordinary practitioner because this is how thousands of retail computer systems are configured when a purchase transaction has been completed.

**Re. Claim 21**, configuring a processor to initiate a transfer of funds in response to an indication that the order confirmation information has been provided to the retail or wholesale outlet store associated with the order confirmation information would have been obvious to the ordinary practitioner because it is well known that this is standard accounting practice in retailing in order to maintain the integrity of the accounting system in the organization or even between organizations.

**Re. Claims 17-21**, it would have been obvious to the ordinary practitioner of the art at the time of Applicant's invention to combine Kalin's disclosures with the well known retail online sales, distribution, delivery and accounting practices of retail or wholesale outlet stores to distribute purchased goods at retail or wholesale outlet stores, motivated by the opportunity to use brick-and-mortar presence to full online advantage (Kalin, p. 2, ll. 10-11).

### ***Response to Arguments***

2. Applicant's arguments filed February 13, 2006 with respect to claims 1-4, 7-10 and 16-21 have been fully considered but they are not persuasive.

**ARGUMENT:** Applicant argues broadly in regard to the entire set of claim rejections, and then briefly argues more specifically against the rejection of independent claims 1 and 16.

(1) The broad argument is that "... no *prima facie* case of obviousness has been established due to a lack of factual support, MPEP 2142". (p. 7, ll. 2-3). Applicant supports this argument by citing the three requirements for the establishment of a *prima*

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*facie* case of obviousness (p. 6, ll. 6-12), by citing the examiner's initial burden according to MPEP 2142 (p. 6, ll. 18-24), by arguing that the examiner has improperly asserted that certain limitations in the claims are "well known" and that no references are provided to support the well known statements (p. 6, ll. 25-32; p. 8, ll. 16-22), that the examiner's "recollection of the past is tainted with knowledge of present Internet commerce capabilities" (p. 6, l. 33 – p. 7, l. 2), and

(2) Kalin teaches away from Applicant's claim 1 (p. 8, ll. 1-7).

**RESPONSE:**

(1) **Broad Argument:** The examiner is fully aware of the requirements of MPEP 2149, including the need to avoid arbitrary judgements in the establishment of *prima facie* case of obviousness.

The Federal Circuit Court has provided the following opinion within the last month, as follows:

"A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45." In re Kahn, Slip Op. 04-1616, page 9 (Fed. Cir. Mar. 22, 2006).

In this instance, the examiner's review of his use of "well known" statements in certain rejections leads him to conclude that he has met the court's standard to provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness".

Regarding burden of proof:

"[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102 <<http://www4.law.cornell.edu/uscode/35/102.html>>, on 'prima facie obviousness' under

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35 U.S.C. 103 <<http://www4.law.cornell.edu/uscode/35/103.html>>, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

In this case, since the examiner has met his responsibility in establishing a case of obviousness combination with properly articulated reasoning, the burden of proof falls on applicant to prove that the examiner's reasonings are incorrect or unreasonable. Given the examiner's proper rationale to support his characterizations of limitations as well known means that Applicant's requests for references to back up the "well" known statements has not met the required standard for lack of having met Applicant's burden of proof requirement.

## **(2) Re. the "Teaching Away" Argument**

The Examiner is fully aware of the guidelines concerning this argument. The MPEP gives guidelines for teaching away in **MPEP § 2141.02** (prior art must be considered in its entirety, including disclosures that teach away from the claims) and **MPEP § 2143.01** (proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference).

**Case law offers further guidance on the issue of teaching away, in sum stating that the Nature of the Teaching Is Highly Relevant, as expressed in the court's opinions in W.L. Gore & Associates v. Garlock, Inc., and in *In re Gurley*, as follows:**

**(a) W.L. Gore & Associates v. Garlock, Inc.** This (case) involves a teaching of "stretching said (unsintered) PTFE at a 10% per second rate to more than five times the original length. .... A reference teaching rapid stretching of conventional plastic polypropylene with reduced crystallinity combined with a reference teaching stretching unsintered PTFE, would not have suggested rapid stretching of highly crystalline PTFE, in light of the disclosures in the art that teach away from the invention, i.e., that the conventional polypropylene should have reduced crystallinity before stretching, and that PTFE should be stretched slowly".

Having read this court opinion, the examiner concludeS that the relevant aspect of the opinion turned on the court's finding that a technical error had been argued in the justification of an obviousness combination of two teachings. The court finding of a technical distinction in this case could not be clearer. The court found that the combination of the properties of two unrelated polymers was technically incompatible

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and thus the teachings could not be properly combined. Thus the court followed common sense logic.

**(b) The *In re Gurley* opinion offers further guidance on the issue of teaching away, in sum stating that the Nature of the Teaching Is Highly Relevant, as follows:** A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness; however, “the nature of the teaching is highly relevant and must be weighed in substance. A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994) (Claims were directed to an epoxy resin based printed circuit material. A prior art reference disclosed a polyester-imide resin based printed circuit material, and taught that although epoxy resin based materials have acceptable stability and some degree of flexibility, they are inferior to polyester-imide resin based materials. The court held the claims would have been obvious over the prior art because the reference taught epoxy resin based material was useful for applicant’s purpose, applicant did not distinguish the claimed epoxy from the prior art epoxy, and applicant asserted no discovery beyond what was known to the art.).

To summarize, these two court opinions demonstrate that the concept of “teaching away” has technical foundations and requirements of a limited, narrow technical nature of a common sense variety.

In this case, It becomes clear that, contrary to Applicant’s assertion, trends not cited in the reference as teaching away in a manner relevant to the specific use of the disclosures are moot. There are no disclosures in Kalin which prohibit the modification of Kalin’s disclosures from being modified to meet Applicant’s limitations such as storage and distribution of goods that are different from those displayed at the store. The Kalin disclosure involves directly analogous art to that of Applicant’s invention and the modifications would not disable Kalin’s teachings.

### ***Conclusion***

**3. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

*Commissioner of Patents and Trademarks, Washington D.C. 20231*


or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

April 20, 2006

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
Au 3628